

REMARKS

At the time of the Office Action dated November 20, 2002, claims 13-18 were pending and rejected in this application. Claim 13 has been amended, and care has been exercised to avoid the introduction of new matter. Claim 13 has been amended to clarify the limitations recited therein, and the scope of limitations recited in claim 13 has not been narrowed. Claim 17 has been amended to correct a minor typographical error.

Claims 13-18 are rejected under 35 U.S.C. § 102(a) for lack of novelty as evidenced by Jacobs, U.S. Patent No. 6,294,407

On page two of the Office Action, the Examiner asserted that Jacobs discloses a method of manufacturing a package for accommodating electronic part corresponding to that claimed. This rejection is respectfully traversed.

Applicant respectfully submits that the claims have been improperly rejected under subsection (a) of 35 U.S.C. § 102 based upon Jacobs, as the issue date of Jacobs is subsequent to the filing date of the present application. Instead, as the filing date of Jacobs is earlier than the earliest priority date of the present application, upon rejecting the claims 35 U.S.C. § 102, the Examiner should have applied subsection (e) and not subsection (a).

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that one having ordinary skill in the art would have recognized that the identically claimed invention is within

the public domain.¹ Furthermore, the Examiner must also establish that the applied reference identically discloses each feature of the claimed invention.² As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.³ The Examiner's rejection failed to meet this burden as the Examiner has failed to clearly designate the teachings in Jacobs being relied upon. In this regard, the Examiner's rejection also fails to comport to the provisions of 37 C.F.R. § 1.104(c).⁴

For example, although the Examiner asserted that reference numeral 140 in Fig. 1 identifies the claimed buildup substrate, the Examiner failed to identify the claimed power and/or ground layer or the claimed core substrate. Furthermore, the Examiner has also failed to identify the claimed buildup interconnecting layer or the claimed signal lines. The Examiner, therefore, has impermissible forced Applicant to guess as to what in Jacobs the Examiner believes discloses these above-identified missing features. As a result, the Examiner has failed to establish a prima facie basis of novelty under 35 U.S.C. § 102.

¹ ATD Corporation v. Lydall, Inc., 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998); Electro Medical Systems S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

² In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

³ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., *supra*.

⁴ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Not only has the Examiner failed to identically each claimed feature within Jacob, the Examiner has also failed to construe the meaning of the elements in light of the specification. For example, the Examiner asserts that features 130 and 132 disclose the claimed conductive adhesive layer. A review of the teachings in Jacobs regarding features 130 and 132 leads Applicant to conclude that the Examiner has failed to construe the meaning of "conductive adhesive layer" in view of the specification. As discussed in Applicant's specification on page 5, lines 5-6:

the conductive adhesive layer 27 consisting mainly of an adhesive having an even conductivity

In contrast, feature 130 of Jacobs is described as an "adhesive dielectric layer" and feature 132 is described as "conductive vias" (column 6, lines 35-37). Therefore, one having ordinary skill in the art would not recognize the adhesive dielectric layer 130 of Jacobs to be conductive, and one having ordinary skill in the art would not recognize the combination of the dielectric feature 130 and the conductive feature 132 to have an "even conductivity." Thus, the Examiner has inappropriately asserted the features 130, 132 of Jacobs identically describes the claimed conductive adhesive layer.

The above argued differences between the method defined in independent claim 13 and the methodology of Jacobs undermines the factual determination that Jacobs identically describes the claimed invention within the meaning of 35 U.S.C. § 102.⁵ Applicant, therefore, respectfully

⁵ Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

submits that the imposed rejection of claim 13 under 35 U.S.C. § 102 for lack of novelty as evidenced by Jacobs is not factually viable and, hence, solicit withdrawal thereof.

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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